



ur Docket No: 42P15770

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/611,326
First Named : William W. Macy
Inventor :
Filed : June 30, 2003 Art Unit: 2155
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Examiner : David Y. Eng
Docket No. : 42P15770
Customer No. : 45209

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SECOND NOTIFICATION OF RELATED LITIGATION UNDER MPEP § 2001.06 (C)

Examiner:

Applicants previously submitted a first NOTIFICATION OF RELATED LITIGATION UNDER MPEP § 2001.06(C) (and associated materials) in the above-identified case on 7/20/2007. The Notification of Related Litigation pertains to U.S. Patent No. 6,418,529 ("the '529 patent").

Since then a number of documents have been filed in the suit. One of the documents is TRANSMETA CORPORATION'S AMENDED AND SUPPLEMENTAL RESPONSES TO INTEL CORPORATION'S FIRST SET OF INTERROGATORIES (NOS. 1, 3, 4, 5, 8, 13, AND 15)¹. In this document, response to Interrogatory 13 includes an allegation that "claims 30, 36, and 48 are anticipated by and/or obvious in view of each of" twelve identified references "taken alone or in combination". See e.g., pages 32-35. The supplemental response to Interrogatory 13 also identifies various combinations of references (see e.g., pages 34-35) and "provides an exemplary claim chart setting forth the bases for its invalidity contentions with respect to claims 30, 36, and 48 of the '529 patent". Specifically, Exhibit 18 of the supplemental response to

¹ Listed on the accompanying IDS as: TRANSMETA CORPORATION'S AMENDED AND SUPPLEMENTAL RESPONSES TO INTEL CORPORATION'S FIRST SET OF INTERROGATORIES (NOS. 1, 3, 4, 5, 8, 13, AND 15) (Redacted Version), In the United States District Court for the District of Delaware, In the matter of Transmeta Corporation v. Intel Corporation, C.A. No. 06-633-GMS, dated August 23, 2007, 84 pages (including Exhibits 15-18 totaling 46 pages).

Interrogatory 13 allegedly “identifies specific examples where each limitation of claims 30, 36, 48 of the ‘529 patent is found in the prior art references”.

About two-thirds of the twelve references have already been submitted in an Information Disclosure Statement (IDS) in the above-identified case (see e.g., the IDS dated 7/20/2007). All of the identified references that have not already been submitted are being submitted in the accompanying IDS.

Other documents submitted in the suit pertain to conception, actual reduction to practice, and diligence toward constructive reduction to practice of the Intel patents in suit. Response to Interrogatory 21 of INTEL CORPORATION’S RESPONSES TO TRANSMETA’S FIRST SET OF INTERROGATORIES TO INTEL CORPORATION (NOS. 1-24)² includes information on conception of the ‘529 patent. See e.g., page 128. Supplemental responses to Interrogatories 21-23 of INTEL CORPORATION’S SUPPLEMENTAL RESPONSES TO TRANSMETA INTERROGATORY NOS. 8, 9, 12, 19, AND 21-23³ provide supplemental information on conception, actual reduction to practice, and diligence toward constructive reduction to practice of the ‘529 patent, respectively. See e.g., pages 22, 23, and 25.

Other documents submitted in the suit pertain to claim construction. Claim construction terms identified for the ‘529 patent include “packed data”, “copying”, and “decoding”. INTEL CORPORATION’S OPENING CLAIM CONSTRUCTION BRIEF⁴ includes Intel Corporation’s positions for claim construction. See e.g., pages 57-58 for a discussion pertaining to “packed data”. See e.g., page 58 for a discussion pertaining to “copying” and “decoding”. TRANSMETA CORPORATION’S OPENING CLAIM

² Listed on the accompanying IDS as: INTEL CORPORATION’S RESPONSES TO TRANSMETA’S FIRST SET OF INTERROGATORIES TO INTEL CORPORATION (NOS. 1-24), In the United States District Court for the District of Delaware, In the matter of Transmeta Corporation v. Intel Corporation, C.A. No. 06-633-GMS, dated May 18, 2007, pages 1-132.

³ Listed on the accompanying IDS as: INTEL CORPORATION’S SUPPLEMENTAL RESPONSES TO TRANSMETA INTERROGATORY NOS. 8, 9, 12, 19, AND 21-23, In the United States District Court for the District of Delaware, In the matter of Transmeta Corporation v. Intel Corporation, C.A. No. 06-633-GMS, dated August 23, 2007, pages 1-27.

⁴ Listed on the accompanying IDS as: INTEL CORPORATION’S OPENING CLAIM CONSTRUCTION BRIEF, In the United States District Court for the District of Delaware, In the matter of Transmeta Corporation v. Intel Corporation, C.A. No. 06-633-GMS, dated October 19, 2007, pages 1-76.

CONSTRUCTION BRIEF⁵ includes Transmeta Corporation's positions for claim construction. See e.g., pages 56-58 for a discussion pertaining to "packed data". See e.g., pages 58-59 for a discussion pertaining to "copying" and "decoding". In the document FINAL JOINT CLAIM CONSTRUCTION CHART⁶, both parties submit their final joint claim construction charts. The chart regarding Intel's patents is attached at Tab B. See e.g., pages 33-38 of Tab B for the '529 patent.

Intel Corporation has filed reexamination requests for all eleven of the patents asserted by Transmeta Corporation. By September 4, 2007, the USPTO had ruled that all of Intel's requests for reexamination raise substantial new questions regarding the patentability of the patents asserted by Transmeta. I am not aware of any reexamination requests filed by Transmeta against the Intel patents in suit. On October 24, 2007, Transmeta Corporation published a press release on their website entitled TRANSMETA ANNOUNCES SETTLEMENT OF PATENT LITIGATION, TECHNOLOGY TRANSFER AND LICENSE AGREEMENT WITH INTEL⁷. In this press release, Transmeta Corporation announced that it has reached an agreement with Intel Corporation to settle all claims between them.

Invitation for a telephone interview

The Examiner is invited to call the undersigned at (408) 720-8300 if there are any questions regarding this material.

Charge our Deposit Account

Please charge any shortage to our Deposit Account No. 02-2666.

⁵ Listed on the accompanying IDS as: TRANSMETA CORPORATION'S OPENING CLAIM CONSTRUCTION BRIEF, In the United States District Court for the District of Delaware, In the matter of Transmeta Corporation v. Intel Corporation, C.A. No. 06-633-GMS, dated October 19, 2007, pages 1-66.

⁶ Listed on the accompanying IDS as: FINAL JOINT CLAIM CONSTRUCTION CHART, In the United States District Court for the District of Delaware, In the matter of Transmeta Corporation v. Intel Corporation, C.A. No. 06-633-GMS, dated October 10, 2007, pages 1-215.

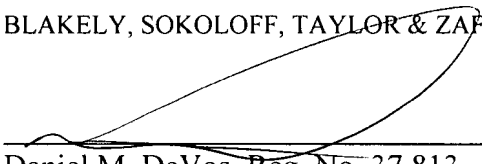
⁷ Listed on the accompanying IDS as: TRANSMETA ANNOUNCES SETTLEMENT OF PATENT LITIGATION, TECHNOLOGY TRANSFER AND LICENSE AGREEMENT WITH INTEL, Press Release, dated October 24, 2007, printed from the Internet site (<http://investor.transmeta.com/releasedetail.cfm?ReleaseID=271024>), one page.

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Respectfully submitted,

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